

209060US0



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
ISABELLE AFRIAT : EXAMINER: WELLS
SERIAL NO: 09/884,949 :
FILED: JUNE 21, 2001 : GROUP ART UNIT: 1617

FOR: COMPOSITION IN THE FORM OF A
WATER-IN-OIL EMULSION WITH
A VARIABLE SHEAR RATE AND
METHODS OF USING THE SAME

REQUEST FOR RECONSIDERATION

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

In response to the Office Action mailed October 23, 2003, Applicant respectfully requests reconsideration of the present application in view of the following remarks.

The Office Action rejected claims 1-22 and 25-29 under 35 U.S.C. § 103 as obvious over U.S. patent 5,851,539 ("Mellul"), and claims 23 and 24 under 35 U.S.C. § 103 as obvious over Mellul in view of The Condensed Chemical Dictionary. In particular, the Office Action identified several perceived deficiencies with the two previously-submitted Rule 132 declarations in this case.

In response to the outstanding Office Action, Applicant submits herewith a third Rule 132 declaration in which all of the perceived deficiencies of the previously-submitted declarations are addressed. Specifically, regarding the Office Action's assertion that no data

RECEIVED
JAN 27 2004
TECH CENTER 1600/2300

Application No. 09/884,949
Response to Office Action dated October 23, 2003

exists showing that formulation nos. 658462-2 and 658463-3 readily break, the new declaration points out that graphs depicting this data were inadvertently not attached to the August 18, 2003, declaration, but that a copy of these graphs is attached to the new declaration.

Regarding the Office Action's assertion that no data exists showing that Example 1 of the present application or CM 3/1 readily break, the new declaration explains that Example 1 is "Reference P5" discussed in the July 24, 2002, declaration, so data has been provided for this invention composition. Regarding CM 3/1, the new declaration states that the portion of the graph reflecting that this composition breaks is at 240 Pa. However, because CM 3/1 contains only 79.83% aqueous phase and, thus, is on the outer limits of the claimed invention, the breaking of this composition is more difficult to determine than for compositions containing more aqueous phase.

Regarding the Office Action's assertion that the reproduction of Mellul's compositions as CM 3/3, CM 3/4 and CM 3/5 was inappropriate because Mellul was not followed exactly, the new declaration points out that Mellul's col. 7, line 57, and col. 8, line 6 indicate that glycerin and sodium chloride can be added to Mellul's compositions, so their addition to CM/3, CM/4 and CM/5 is appropriate. Moreover, the new declaration explains that their presence or absence would not be expected to materially alter the properties of the resulting composition.

The new declaration goes on to explain that KF 6015 was used instead of KF 6017 because Mellul indicates that these dimethicone copolyols are interchangeable and because KF 6015 was readily available. Finally, the new declaration states that hydrocarbon surfactant found in Mellul's example 24 was not included in CM/3, CM/4 and CM/5 because

Application No. 09/884,949
Response to Office Action dated October 23, 2003

Mellul's Tables I and II indicate that the presence of hydrogen surfactant results in a very unstable emulsion, whereas silicone surfactant results in a stable emulsion. The declarant notes that because they were attempting to create the most stable emulsion possible in accordance with Mellul's teachings, Mellul's hydrocarbon surfactant was not utilized.

Regarding the Office Action's assertion that given the data points provided it is not possible to determine if CM 3/5 has a break property at shear stress greater than 100 Pa, the declaration notes that it is impossible to apply a greater stress to CM 3/5 because this composition is too fluid, but that the cream-like compositions of the present invention are thicker, so more shear stress can be applied to them.

In view of the above, Applicant respectfully submits that all issues raised by the Examiner relating to Applicant's previously-submitted declarations, as well as the data contained therein, have been satisfactorily explained and/or clarified.

All of Applicant's Rule 132 declarations have focused on the improved rheological characteristics of the claimed W/O emulsions (having 80% or more aqueous phase) related to their ability to "break" more readily than W/O emulsions containing less aqueous phase (70% aqueous phase), leading to better fluidization properties and, hence, greater freshness upon application to skin than emulsions containing prior art amounts of aqueous phase, a "surprising and unexpected difference" between these emulsions.

In addition to having improved rheological properties, the claimed compositions, despite their high water content, are stable even when stored under conditions of fluctuating temperatures. (Page 3, lines 19-21). The examples in the present specification demonstrate that the claimed compositions possess good stability under such conditions, whereas comparative compositions do not.

Applicant submits that the improved rheological and physical characteristics of the claimed compositions as set forth and explained in all of the submitted Rule 132 declarations, as well as the compositions' improved stability under fluctuating temperature conditions, demonstrate that the claimed compositions are not obvious and, thus, deserving of patent protection.

Thus, even assuming *arguendo* that the Office Action has established a *prima facie* case of obviousness --which it has not¹-- the Rule 132 declarations submitted in this case and the examples in the specification are more than sufficient to overcome such a hypothetical *prima facie* showing. The declarations demonstrate that W/O emulsions containing 80% or more aqueous phase "unexpectedly and surprisingly" break more readily than emulsions containing less aqueous phase, meaning that the former compositions have more aqueous phase available for contact with skin than the latter emulsions. The declarations indicate that this difference is significant because it provides W/O emulsions having 80% or more aqueous phase a fresher feeling upon application, an important characteristic in the cosmetic field. The declarations also demonstrate that compositions corresponding to Mellul's Example 24 are unsuitable for use in the cosmetic industry, unlike the claimed invention. Finally, the examples in the present specification demonstrate that compositions containing the claimed silicone surfactant are more stable under fluctuating temperature conditions than compositions containing other silicone surfactants, making the former compositions better suited for commercial production, storage and transport than the latter compositions.

¹ Applicant's July 24, 2002, response sets forth the reasons why no *prima facie* case of obviousness has been established. For sake of brevity, Applicant will not repeat these arguments herein.

Application No. 09/884,949

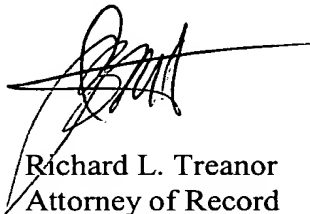
Response to Office Action dated October 23, 2003

In view of the above, Applicant respectfully requests that the rejections under 35 U.S.C. §103 be withdrawn.

Applicant believes that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Richard L. Treanor
Attorney of Record
Registration No. 36,379

Jeffrey B. McIntyre
Registration No. 36,867

Customer Number

22850

Phone: (703) 413-3000

Fax #: (703) 413-2220